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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/754,391

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Daniel H. Schneider

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EXAMINER

SKURDAL, COREY NELSON

ART UNIT

PAPER NUMBER

3782

MAIL DATE

DELIVERY MODE

06/05/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/754,391

Applicant(s)

SCHNEIDER, DANIEL H.

Examiner

Corey N. Skurdal

Art Unit

3782

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 13-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 13-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/23/2007 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

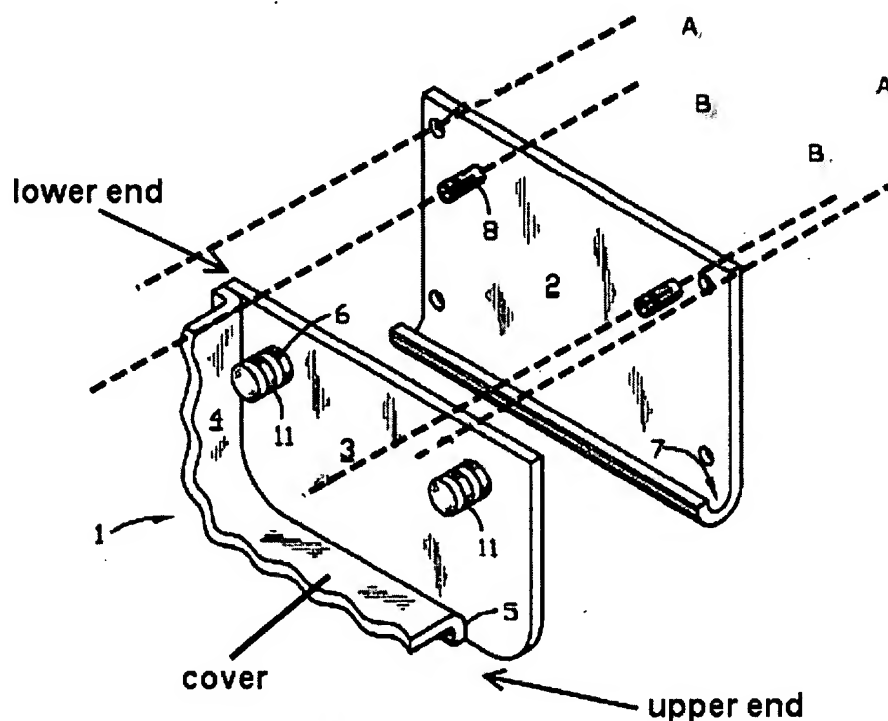
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 8, 26, 27, and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Campbell (US 6,499,638).

Regarding claims 1 and 8, Campbell discloses a saddlebag mounting system capable for use with a motorcycle having a fender support as claimed, including: a saddlebag 1 having (see Examiners Figure 1 below) a lower end and an upper end defining an upward direction, a cover being located at the upper end; a saddlebag frame 3 fixedly attached to the saddlebag; and a hook member at 5 integrally formed as part of the saddlebag, said hook adapted to couple a portion of the motorcycle and partially support the saddlebag; saddlebag frame 3 further includes first and second attachment members 6 configured to couple the saddlebag to a portion of the motorcycle; and

wherein the hook member at 5 is positioned above the positions of the first and second attachment members depending on how one looks at the figures, and furthermore wherein a central portion of the hook member at 5 is located between the attachment members.



EXAMINERS FIGURE 1

Regarding claims 26 and 27, Campbell discloses a saddlebag mounting system essentially as claimed, including: a saddlebag 1 having (see Examiners Figure 1 below) a lower end and an upper end defining an upward direction, a cover being located at the upper end; a saddlebag frame 3 fixedly attached to the saddlebag; a hook member 5 integrally formed as part of the saddlebag said hook adapted to couple a portion of the motorcycle and partially support the saddlebag; first and second attachment members 8 spaced a distance from each other, the attachment members substantially inhibiting

movement of the saddlebag in any direction, including the upward direction when the saddlebag is coupled to the motorcycle, and wherein the hook member at 5 is positioned above the positions of the first and second attachment members depending on how one looks at the figures, and furthermore wherein a central portion of the hook member at 5 is located between the attachment members.

Regarding claim 30 the modified device of Campbell discloses first and second attachment members being pins 6, each being engageable with the saddlebag and motorcycle.

Regarding the newly added language in claims 1 and 26, see Examiners response to arguments.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2-5, 7, 9-11, 13, 14, 16-22, 24, 28, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Campbell in view of Monson (US 2003/0122002).

Regarding claims 2, and 7 Campbell discloses the claimed invention substantially as claimed including: a mounting system with hook 5 adapted to engage the mount 2. Campbell does not disclose that the mounting system is secured to the fender support of a motorcycle, or the use of a yoke member engageable with the motorcycle.

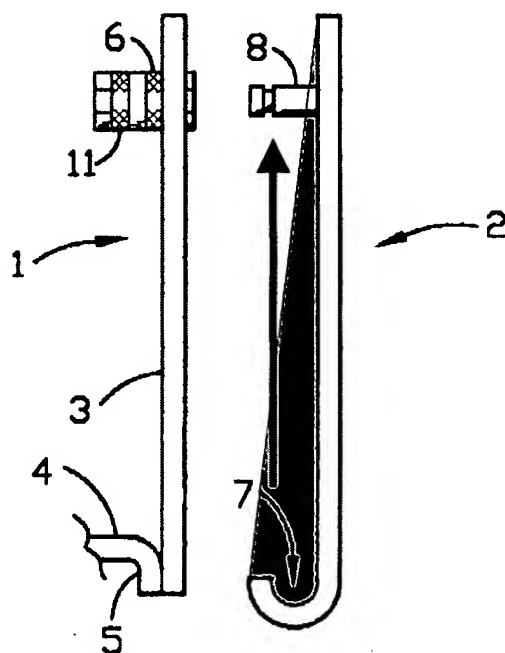
However, Monson teaches the use of a saddlebag mounting system attached to a fender strut 14, the fender strut 14 holding the fender 24 above the wheel and therefore being considered a fender support (see paragraph 44 of Monson). Monson also teaches the use of a yoke member 94' (Fig. 3A) formed as part of the saddlebag frame 44'' for the purpose of supporting the saddlebag. Therefore it would have been obvious to one skill in the art at the time of invention to provide Campbell with attachment to the motorcycle fender support in order to increase the strength of the attachment point, and also to provide the saddlebag frame of Campbell with a yoke member extending from the motorcycle in order to provide additional support for the saddlebag.

Regarding claims 3-5, the modified device of Campbell discloses a saddlebag mount including: a bar 2 attached to the fender support by first and second mounting points 10, spaced a distance from each other; first and second attachment members 8 adapted to couple the saddle bag, each attachment member being disposed between said mounting points; and wherein said first and second attachment members of the saddlebag frame are pins 6 engageable with said first and second attachment members 8 of said bar.

Regarding claim 9, the modified device of Campbell discloses a saddlebag and a mounting system as claimed, wherein the saddlebag mount includes a first and second mounting axis disposed through the first and second mounting holes 10, and being attached to the fender support as applied to claim 2, along saddlebag frame 3 having an attachment axis disposed through the attachment points 6, whereby the mounting axes and attachment axis are not aligned. Furthermore, Campbell discloses the saddlebag

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mount including bar member 2 having a cavity (shown in Examiners Figure 2 shaded in) formed within the lip 7, the cavity having an opening which can face in any number of directions, including away from the saddlebag and toward the fender support, and wherein first and second attachment members 8 of the bar are disposed within the bounds of cavity.

Examiners Figure 2

Regarding claims 10, 11, 19 and 20, the modified device of Campbell discloses a hook member at 5 integrally formed as part of the saddlebag said hook adapted to couple a portion of the motorcycle and partially support the saddlebag.

Regarding claim 13, the modified Campbell device discloses the claimed invention including: first and second attachment members 8 disposed between the first and second mounting axes, the attachment members adapted to couple the saddlebag.

Regarding claim 14, the modified Campbell device discloses first and second pins 6 engageable with attachment members 8 on the saddlebag mount.

Regarding claims 16, 24, 28, and 29 the modified Campbell device discloses the claimed invention including yoke support 94' engageable with the motorcycle to partially support the saddlebag.

Regarding claim 17, the modified Campbell device discloses mounting axes (A in Figure 1 shown above) and attachment axes (B in Figure 1 shown above) in the claimed configuration including mounting axes through parallel spaced holes 10, and attachment axes oriented parallel each other and between said mounting axes.

Regarding claim 18 the modified Campbell device discloses a saddlebag mounting system with saddlebag 1, a saddlebag mount including bar 2 extending along the motorcycle, and a saddlebag frame 3, which engages the bar and supports the saddlebag, wherein the bar defines a cavity (shown in Examiners Figure 2 shaded in) formed within the lip 7, the cavity having an opening which can face in any number of directions, including away from the saddlebag and toward the fender support, and wherein first and second attachment members 8 of the bar are disposed within the bounds of cavity.

Regarding claims 21 and 22, the modified Campbell device discloses the bar 2 with first and second attachment members 8 adapted to couple the saddle bag, each attachment member being disposed between mounting points 10 and first and second pins 6 engageable with said first and second attachment members.

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6. Claims 6, 15, 23, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Campbell in view of Monson and in further view of Ralph et al (US 2,887,753). The modified Campbell device discloses the invention substantially as claimed as applied in paragraph 6 above, but the modified Campbell device does not disclose first and second pin members with a cam surface that engages the first and second attachment members. However, Ralph et al teaches the use of a fastening device with quick connect and disconnect ability with pin 12, cam surface 11, S-spring 10 wherein the cam surface engages the spring. Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to exchange the quick disconnect pins and attachment members of Campbell with the quick disconnect pin 12 and attachment member 10 of Ralph et al, in order to increase the strengthen of the attachment points.

7. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Campbell in view of Monson as applied to claim 18 above, and further in view of Seibel (US 6,347,804). The modified Campbell device discloses the invention substantially as claimed but does not have a pair of spacers for supporting an accessory. However, Seibel teaches the use of mounting member 24 with spacer's 36a for the purpose of supporting an accessory such as a backrest. Therefore it would have been obvious to one skill in the art at the time of invention to provide the mounting system of Campbell with spacers at behind mounting holes 10 in order to provide an additional mounting point for accessories.

Response to Arguments

8. Applicant's arguments filed 4/23/2007 have been fully considered but they are not persuasive.

Applicant has argued that Campbell fails to teach the hook member positioned above the attachment members, specifically in relation to an upper ward direction defined by an upper and lower end of the saddlebag. Applicant also argues that Campbell/Monson fails to teach a bar having a cavity which faces away from the saddlebag.

Regarding the amended language of claims 1 and 26, they recite no structure that prevents a lower end, an upper end, and a cover from being defined as shown in Examiners Figure 1. It is not required that the saddlebag frame be specifically attached to the motorcycle in any orientation, rather that it be ***adapted*** to couple to a portion of the motorcycle. As such, one can simply flip the saddlebag frame 3 of Campbell upside down, and define an alternate upward direction that places the hook member 5 above the attachment members 6. Regarding the cover portion, no specific structure is recited in the claim as what is encompassed by the cover, and as such Examiner is considering the gusset portion 4 of the saddlebag to be a cover.

Regarding the orientation of the cavity in claim 9 and 18, the cavity of Campbell as shown in Examiners Figure 2 is considered to face in any number of direction, including up and away from the saddlebag frame (as indicated by the arrow originating from the shaded area). Furthermore, claim 9 only requires that there be a saddlebag mount and a saddlebag frame which are engageable, but are not specifically connected.

As such, one could simple place the saddlebag frame 3 on the opposite side of the motorcycle as the saddlebag mount, such that the cavity faces away from the saddlebag and toward the fender support.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corey N. Skurdal whose telephone number is 571-272-9588. The examiner can normally be reached on M-Th 8am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Newhouse can be reached on 571-272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CNS 5/23/07


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SUPERVISORY PATENT EXAMINER